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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,987	11/17/2003	Yoshihiro Yazawa	1356-DIV-01	2265

35811 7590 09/30/2005

IP GROUP OF DLA PIPER RUDNICK GRAY CARY US LLP
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EXAMINER

YEE, DEBORAH

ART UNIT PAPER NUMBER

1742

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/714,987

Applicant(s)

YAZAWA ET AL.

Examiner

Deborah Yee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3 and 4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3 and 4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 10/016,543.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 3 and 4 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over European patent 675206 , European patent 1113084, Kato et al (US Patent 6,113,710), European patent 930375 or Sato et al (US Patent 5,110,544) in view of Imai et al (US Patent 6,455,476).
4. EP'206 on lines 31 to 46 on page 7, EP'084 claims 4 to 5 on page 16, Kato claims 1 to 3 of column 9, EP'375 claims 1 to 6 on page 9, and Sato abstract, each discloses a ferritic stainless steel sheet having a composition with constituents whose wt% ranges overlap those recited by the claims; such overlap renders applicant's composition prima facie obvious because it would be obvious to one of ordinary skill in the art to select the claimed alloy ranges from the broader disclosure of the prior art since the prior art has similar utility and properties, see MPEP 2144.05.

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5. More specifically, note alloy examples 1-17 in Table 1 of columns 9-10 of Kato, Sato alloys 11 and 14 in Table 1 of columns 7 and 8, and EP'375 alloy 9 in Table 1 on page 8 which meet the claimed composition. Also EP'084 in Table 1 on page 9 and EP'206 in Table 1 on page 9 disclose examples which meet the claimed composition except do not contain V or Mo. It would, however, be obvious to include V or Mo since they are taught as additional alloying elements in the general disclosure of the prior art.

6. Even though prior art does not teach lubricating steel surface with a coating comprising an acrylic resin, calcium stearate, and polyethylene wax as recited by the claims, such would not be a patentable difference because it is well known and conventional practice in the metallurgical art to coat steel surface with a lubricant to further enhance workability as evident by Imai et al. Note that Imai on lines 15 to 26 of column 11 discloses a lubricant for the plastic working of steel having a composition containing acrylic resin with polyethylene wax dispersion and/or calcium stearate dispersion which meets the recited claims. Since enhance workability and press formability are properties desired and sought by primary prior art, then it would be an obvious modification well within the skill of the artisan to apply lubricant to prior art steel surface in view of Imai to produce no more than the known and expected effect from such an additional step. Also the coating amount of 0.5 to 4.0 g/m² would be a matter of choice and routine optimization well within the skill of the artisan and productive of no new and unexpected results.

7. Even though prior art does not teach a ridging height of about 50 microns or less at a 25% deformation in uni-axial stretch as recited by claim 4, such would be expected


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since compositional limitations are met and anti-ridging properties are taught, and in absence of proof to the contrary.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Yee whose telephone number is 571-272-1253. The examiner can normally be reached on Monday-Friday from 6:00 to 2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Deborah Yee
Primary Examiner
Art Unit 1742

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